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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,683	04/02/2004	John Overman	63288-660	9777
7590	07/01/2005			EXAMINER TRAN, KHOI H
Keith E. George, Esq. McDermott, Will & Emery 600 13th Street, N.W. Washington, DC 20005-3096			ART UNIT 3651	PAPER NUMBER

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/815,683	OVERMAN ET AL.
	Examiner Khoi H. Tran	Art Unit 3651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 31 May 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 13-19 and 29-41 is/are pending in the application.
- 4a) Of the above claim(s) 29-41 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 13-19 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

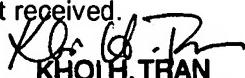
Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


KHOI H. TRAN
PRIMARY EXAMINER

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>04/04</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group III, claims 13-19 in the reply filed on 05/31/2005 is acknowledged.

Newly added claims 29-41 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Grouping (see Restriction Requirement below), there being no allowable generic or linking claim.

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 13-19, drawn to a mailpiece feeder assembly with the particulars of the lifting and gripping mechanisms, classified in class 414, subclass 796.9.
 - II. Claims 29-35, 37, and 38 drawn to a mailpiece feeder assembly having general lifting mechanism, general gripping mechanism, and the details of a platform, classified in class 414, subclass 796.5.
 - III. Claims 37 and 39-41, drawn to a mailpiece feeder assembly having a platform with the details of the lifting and gripping mechanisms, classified in class 414, subclass 797.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions II and I, III and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other

combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because claims 29 and 37 serve as evidence that the combination does not required the particulars of the subcombination for patentability. The subcombination has separate utility such as for use in a system without a movable platform. Pursuant to MPEP 806.05c (III), this instant Restriction requirement is proper. Claims 29 and 37 are AB^{br}, claims 13-19 are B^{sp}, and claims 39-41 are AB^{sp}.

4. Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as for use in a system wherein both lifting and gripping mechanisms are hydraulically operated. See MPEP § 806.05(d).

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. Since Applicant had elected Group I, claims 13-19 for prosecution, claims 29-41 have been withdrawn from further consideration by the examiner.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 13 and 15-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Moltrasio et al. 4,516,762.

Moltrasio '762 discloses a flat article feeder assembly per claimed invention.

The assembly comprises a suction-cup lifting mechanism having a separator for separating the top article from the stack of articles (Figures 1, 3, and 6). The assembly comprises gripping mechanism 25/26 having a jaw for removing the article from the gripping mechanism (Figure 6). Since Moltrasio '762 anticipates all structural limitations of the claimed invention, it is inherent that the assembly could be used in a mailpiece handling environment.

9. Claims 13-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Wilits et al. 4,958,824.

Wilits '824 discloses a sheet feeder assembly per claimed invention. The assembly comprises a suction-cup lifting mechanism for separating the top sheet from the stack of sheets (Figures 2-6). The assembly comprises gripping mechanism for removing the article from the gripping mechanism (Figure 4). The assembly comprises at least one sensor for activating the lifting and the gripping mechanism. Since Wilits '824 anticipates all structural limitations of the claimed invention, it is inherent that the assembly could be used in a mailpiece handling environment.

10. Claims 13 and 15-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Swaneck 5,029,836.

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Swaneck '836 discloses a paper sheet feeder assembly per claimed invention.

The assembly comprises a suction-cup lifting mechanism having a separator (piston element) for separating the top article from the stack of articles (Figures 1, 2, and 4).

The assembly comprises gripping mechanism 51 having a jaw for removing the article from the gripping mechanism (Figure 4). Since Swaneck '836 anticipates all structural limitations of the claimed invention, it is inherent that the assembly could be used in a mailpiece handling environment.

11. Claims 13 and 15-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Leu 5,398,920.

Leu '920 discloses a print sheet feeder assembly per claimed invention. The assembly comprises a suction-cup lifting mechanism having a separator (crank assembly) for separating the top article from the stack of articles (Figures 1, 3, and 4). The assembly comprises gripping mechanism having a jaw for removing the article from the gripping mechanism (Figure 1). Since Leu '920 anticipates all structural limitations of the claimed invention, it is inherent that the assembly could be used in a mailpiece handling environment.

12. Claims 13-15, 18, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Focke et al. 5,417,543.

Focke '543 discloses a stack feeder assembly per claimed invention. The assembly comprises a lifting mechanism for separating the top article from the stack of articles (Figures 1 and 3-5). The assembly comprises gripping mechanism having a jaw for removing the article from the gripping mechanism (Figures 3-5). The assembly

comprises at least one sensor for activating the lifting and the gripping mechanism.

Since Focke '543 anticipates all structural limitations of the claimed invention, it is inherent that the assembly could be used in a mailpiece handling environment.

13. Claims 13 and 15-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Stauber 5,542,656.

Stauber '656 discloses a print sheet feeder assembly per claimed invention. The assembly comprises a suction-cup lifting mechanism having a separator (crank assembly) for separating the top article from the stack of articles (Figure 8). The assembly comprises gripping mechanism having a jaw for removing the article from the gripping mechanism (Figure 8). Since Stauber '656 anticipates all structural limitations of the claimed invention, it is inherent that the assembly could be used in a mailpiece handling environment.

Conclusion

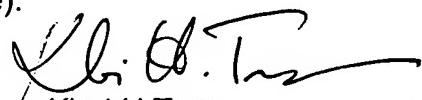
14. Additional references made of record and not relied upon are considered to be of interest to applicant's disclosure: see attached USPTO Form 892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khoi H. Tran whose telephone number is (571) 272-6919. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Crawford can be reached on (571) 272-6911. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Khoi H Tran
Primary Examiner
Art Unit 3651

KHT
06/29/2005